

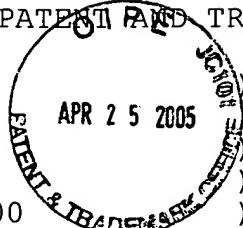
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: RICHARD RUBIN

Serial No.: 09/664,885

Filed: 19 SEPTEMBER 2000

For: INSULATED FOOD CONTAINER



Ex: PASCUA

Art Unit: 3727

CERTIFICATE OF MAILING

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Appeal Brief Patents

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APR 27 2005

TECHNOLOGY CENTER

Dear Sir:

I hereby certify that the attached Transmittal of Appeal Brief; Appeal Brief; Check for Appropriate Fee and a postcard are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450 Alexandria, VA 22313-1450, on 22 April 2005.


Signature

22 April 2005

22 April 2005

Date

Respectfully Submitted,



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APR
3727

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: RICHARD RUBIN)
Serial No.: 09/664, 805) Ex: PASCUA
Filed: 19 SEPTEMBER 2005) Art Unit: 3727
For: INSULATED FOOD CONTAINER)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed is the Brief on Appeal and two copies of the same, in compliance with the Rules, in the above captioned matter, a check in the amount of \$250.00, the requisite fee set forth in 37 CFR 1.17(c) and postcard for return receipt.

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Respectfully submitted,

Robert A. Parsons
Attorney for Applicant
Registration No. 32,713



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Date: 27 June 2003

RUBIN, RICHARD

Art Unit: 3727

Serial No.: 09/664,885

Filed: 19 September 2000

Examiner: Pascua, Jes F.

For: INSULATED FOOD CONTAINER

BRIEF FOR APPELLANT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Appeal Brief Patents

SIR:

Please consider the contents of the following Brief for Appellant.

I. REAL PARTY IN INTEREST

All of the right, title and interest in and to the above-described Patent Application are owned by appellant.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the above described Patent Application.

III. STATUS OF THE CLAIMS

1. A copy of claims 1-20, all of the claims in the application, is provided in Appendix A.
2. Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walsh (U.S.P. 3,428,103).

**IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL
REJECTION**

Appellant did not respond to a Final Rejection mailed 2 February 2005 and no amendments were proposed.

V. EXPLANATION OF THE INVENTION

The application on appeal discloses and claims apparatus for keeping food warm and moist, one embodiment of which is illustrated in FIGS. 1 and 6, with the design and function described and explained on pages 6-12 of the present specification.

In the embodiment of FIGS. 1 and 6, the apparatus 10 includes a pouch 11, constructed to define an insulated and substantially water impermeable food warming chamber 14, with a film 13 of plastic material to provide water impermeability. Pouch 11 has opposing substantially coextensive lips 30, 31 defining a food passage 35 into food warming chamber 14. Lips 30, 31 are formed to provide a passive, non-sealing engagement causing a partial enclosure of food warming chamber 14. The partial enclosure is constructed to inhibit a build-up of moisture vapor produced from warm food (e.g. tortillas 15) disposed in food warming chamber 14, thereby preventing warm food disposed in food warming chamber 14 from becoming soggy while allowing enough moisture vapor to remain in food warming chamber 14 to keep warm food disposed in the warming chamber moist.

VI. ISSUE FOR REVIEW

The single issue is whether claims 1-20 are patentable over the previously cited reference, Walsh (U.S.P. 3,428,103) ?

VII. GROUPING OF CLAIMS

Appellant believes that all of the claims stand or fall together.

VIII. **ARGUMENT**

While the Final Rejection mailed 2 February 2005 states a single rejection and, thus, implies a single issue for appeal, appellant believes it is imperative to understand that several other controversies arise because of the nature of that single rejection. In view of the fact that this is appellant's second appeal on the same cited art, appellant believes that these additional controversies must be considered. Accordingly, appellant has responded to these controversies first and then responded to the single issue of obviousness.

CONTROVERSIES

I. Appellant believes there is a strong possibility that reopening prosecution after losing an appeal without citing new art is improper. There is a strong presumption that all of the art cited by the Examiner was considered and only the best art of the cited art was applied. This presumption is implicit in 37 C.F.R. § 1.104, which states that the Examiner shall make a thorough investigation of the available prior art. The Rule further states that every action **shall** be complete with respect ... to the patentability of the invention. A stated reason for this action on the part of the Patent

Office is so that the applicant can judge the propriety of continuing the prosecution. Even more so, it provides continuity and faith in the system. In the present case, for example, 23 references were cited by the Patent Office and 3 were cited by applicant prior to the reopening of prosecution. Potentially, by the procedure just initiated, appellant could be looking at 15 or 20 additional appeals. This is unconscionable and clearly not within the Patent Law or Rules.

II. Also, Appellant believe there is a strong possibility that *res judicata* makes reopening prosecution improper, when the rejection is on the same cited prior art considered prior to winning the appeal. Appellant understands that the Patent Office can reopen prosecution after losing an appeal. This premise was well litigated in *The Jeffry Manufacturing Co. v. Kingsland, Comr. Pats.*, 77 USPQ 500 (Dist. Court D.C. 1948) and 83 USPQ 494 (Appls. Court D. C. 1949). However, in all such cases the reopening was based on the citation of new prior art. The reason for this, of course, is that all of the art cited prior to the appeal was considered by and comes within the decision of the court (or the Board) of appeals. Thus, since the old prior art was considered by the court (or the Board) of appeals, *res judicata* applies to using it to reopen prosecution. Here it must be remembered that the "res judicata doctrine imposes

finality of decision not only upon issues actually raised but upon issues which might have been raised." *Knutson et al. v. Gallsworthy*, 74 USPQ 327 (Co. of App. D.C. 1947).

In fact, in *The Jeffry Manufacturing Co. v. Kingsland, Comr. Pats.*, 77 USPQ 500 (Dist. Court D.C. 1948) and 83 USPQ 494 (Appls. Court D. C. 1949), the Court specifically decided

After Court of Customs and Patent Appeals reverses rejection of claims, Patent Office may reject claims on basis of additional prior art references not previously cited; this is exception to general doctrine of *res judicata*.

Clearly, the Court is saying that any attempts to reopen prosecution on prior art previously cited is subject to *res judicata* and improper.

In his response to appellant's argument that *res judicata* applies, the Examiner simply stated that "the Examiner's Director, E. Rollins-Cross, authorized the Office Action of 08/25/2004 for the consideration of matters not already adjudicated." Appellant finds it difficult to absorb or understand how a Patent Office Director can overrule the Court of Appeals of Washington D.C. or the CCPA without some reason other than a simple "not already adjudicated" statement. As

the Court stated in *Knutson et al.*, *res judicata* applies "not only upon issues actually raised but upon issues which might have been raised." Certainly, it is not unreasonable to expect an Examiner (or the Board of Appeals for that matter) to consider all art that he has cited, especially in view of 37 C.F.R. § 1.104.

III. Further, it is paramount in the U.S. Patent System that there is a presumption of validity on issued patents (35 U.S.C. 282), which arises because it is assumed that the Examiner carefully considered all of the cited art. In any action against a U.S. Patent (e.g. invalidity issues) the "burden of showing invalidity is especially difficult when prior art was before Patent and Trademark Office examiner during prosecution of application." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2d 1525 (CAFC 1990). The reason for this is the 37 C.F.R. § 1.104 proscription against piecemeal actions. Certainly, the Patent Office must have a difficult burden to show obviousness of an invention when reopening prosecution and reapplying prior art that was before the Examiner, and by extension the Board of Appeals, after losing an appeal. Merely, taking judicial notice of a list of items in the claim does not carry this difficult burden. Clearly, if the invention were so obvious in view of a single

patent, the Examiner or the Board of Appeals would have found it during the extensive prosecution.

In the normal course of the legal system, a party that makes a mistake or causes an error has at least as great a burden proving the mistake or error as other parties that must suffer because of the error. Thus, the Patent Office should have at least as great a burden to show that cited art was mistakenly overlooked, rather than simply not considered, as for example an infringer would have in attempting to invalidate the patent. In fact, in the present situation the Patent Office is basically attempting to 'invalidate' claims allowed by the Board of Appeals over the cited art, since the Board of Appeals did not return the application to the Examiner for further consideration but REVERSED him on all issues.

ISSUE

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walsh (U.S.P. 3,428,103). Appellant respectfully traverses this rejection.

In applying the teachings of Walsh, the Examiner in several instances states "a pouch 10 formed of a plastic material 30, 36 to provide water impermeability" (emphasis added). Walsh never in his entire disclosure mentions anything about moisture or water permeability yet the Examiner's summary makes it sound like an intended feature. Whether Walsh's insulated pizza pie container is water impermeable is not discussed by Walsh and, therefore, not taught by Walsh.

All of the claims considered by the Board of Appeals include the element "the lips formed to provide a passive, non-sealing engagement between the lips". The Examiner states that this is inherent in the Walsh structure because "the resilient nature of the insulating material 34 in the walls 16, 20 inherently cause the lips 24 to provide a 'passive, non-sealing engagement between the lips' as claimed." First, no lips are shown or described by Walsh. The number 24 indicates the front of the wall member 14 (Col. 2, lines 17-18). Further, Walsh only describes an opening in front 24 extending part way into the sides. "To permit sealing of article 40 within insulated container 10, the opening is provided with a suitable closure such as a zipper 42." (Col. 2, lines 44-46, emphasis added.) Thus, the only teaching by Walsh as to the character of the opening is that it seals

article 40 within the insulated container. Nothing in the teaching of Walsh even remotely suggests "lips formed to provide a passive, non-sealing engagement between the lips".

The statement by the Board of Appeals on page 9 of their Decision answers this rejection as well, or better, than the previous rejection:

It is clear to us that the teachings of the applied prior art would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the protective case of Attaway to arrive at the claimed subject matter for the reasons set forth by the appellant in the Brief (pp. 14-23). In that regard, the applied prior art is not suggestive of the claimed non-sealing engagement between the lips which inhibits a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist as set forth in independent claims 1, 8 and 14.

In his "response to applicant's argument" on page 5 of the Final Rejection, the Examiner is essentially making the same argument he made to the Board of Appeals in the prior appeal. Here he responds to appellant's argument that "no

lips are shown or described by Walsh" by stating that "the front side 24 as shown in Figs. 1-5 of Walsh meets the recitation 'lips' to the same degree applicant structurally set forth in the claims. This simply is not true.

Appellant's claim 1 specifies "lips defining a food passage into the food warming chamber". As can be seen clearly in Fig. 5 of Walsh, his insulated container has no lips. The front 24 of his container is a portion of wall member 14 and is multi-laminar (Walsh specification, col. 2, lines 10-19). "An opening is provided in front 24 ... the opening is provided with a suitable closure such as a zipper 42." (Col. 2, lines 41-46) Since no specific teaching is included in the disclosure, the drawings must suffice. Fig. 5 clearly shows that the opening in multi-laminar front 24 is simply a cut through the laminations. Only zipper 42 holds the laminations together. Zipper 42 does not constitute 'lips'. Therefore, Walsh's insulated container has no lips.

However, appellant's claim 1 goes on to state "the lips being formed to provide a passive, non-sealing engagement between the lips". The Examiner continues in his argument by stating the recitation "formed to provide a passive, non-sealing engagement between the lips" is merely an intended use. The prior Board of Appeals responded to this very

argument by rejecting it. As quoted above, the previous Board of Appeals specifically stated

In that regard, the applied prior art is not suggestive of the claimed non-sealing engagement between the lips which inhibits a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist as set forth in independent claims 1, 8 and 14.

Appellant respectfully suggests that the decision by the previous Board of Appeals should be sufficient as a responsive argument to the Examiner's continuation of the same argument (*res judicata*). Thus, it is clear that claims 1-20 are not obvious in view of Walsh and are in condition for allowance.

SUMMARY

Accordingly, it is respectfully asserted that appellant's claims 1-20 are clearly allowable and the case is now in condition for allowance. Appellant therefore prays for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

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22 April 2005

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